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1638



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of Timothy P. Croughan

Examiner Kruse, David H.

Serial No. 09/934,973

Group 1638

Filed August 22, 2001

For: Herbicide Resistant Rice

Atty. File 98A9-USC1 Croughan

AMENDMENT

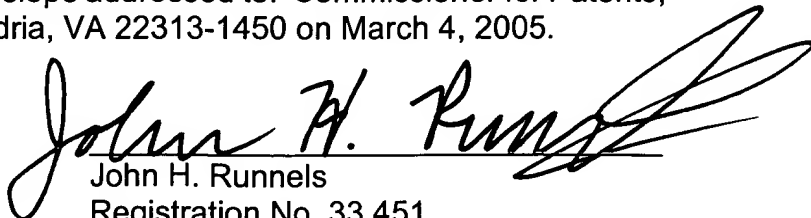
Commissioner for Patents
MS Amendment
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the USPTO Communication mailed on December 22, 2004, and in further response to the June 3, 2004 Office Action, please amend the Claims as shown in Appendix A.

CERTIFICATE

I hereby certify that this Amendment is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, MS Amendment, P.O. Box 1450, Alexandria, VA 22313-1450 on March 4, 2005.


John H. Runnels

Registration No. 33,451
March 4, 2005

Response to December 22, 2004 USPTO Communication

In response to the June 3, 2004 Office Action, Applicant submitted a previous amendment on October 4, 2004. On December 22, 2004, the Office mailed a communication stating that the October 4, 2004 amendment was "not fully responsive to the prior Office Action," on the grounds that the claims as presented in the earlier amendment were said to be "directed to inventions non-elected by original presentation."

It is respectfully submitted that the claims presented in the October 4, 2004 amendment were, in fact, fully consistent with the election made on January 14, 2003. It is respectfully submitted that the December 22, 2004 USPTO Communication should therefore be withdrawn. To perhaps better emphasize the fact that amended Claim 62 and its dependent Claims are consistent with the prior election, Claim 62 has now been rewritten in independent format. Claim 62 as presented below is intended to be identical in substance to Claim 62 as presented in the October 4, 2004 amendment. Only its form has changed, from dependent to independent.

The December 11, 2002 restriction requirement identified three groups of claims: Group I, characterized by the office as "drawn to a herbicide resistant rice plant," Group II, as "drawn to a process for controlling weeds around herbicide resistant rice plants," and Group III, as "drawn to a process for imparting herbicide resistant rice plants."

Applicant's January 14, 2003 Response elected Group I, the herbicide resistant rice plant, and also explained why the non-elected process claims of Groups II and III should be re-joined and examined once the elected Claims had been allowed. The June 3, 2004 Office Action acknowledged (at pages 2-3) that it was proper for the Applicant to keep the non-elected process claims pending in the application, but stated that the restriction requirement would be maintained until an elected product claim had been found to be allowable. See M.P.E.P. § 821.04.

Thus it is entirely proper for Applicant to maintain the non-elected process claims pending in the same application, along with the product claims of Group I.

Pending Claims 62, 64, 66, and 68 are consonant with elected Group I – both as those Claims had been presented in the October 4, 2004 Amendment, and as presented in the present Amendment, changed in form but identical in substance. These Claims are directed to a “herbicide-resistant rice plant,” i.e., to Group I. That these Claims are written in product-by-process form does not alter the fact that they are directed to the product, the rice plant, and therefore fall within elected Group I.

Note particularly the third paragraph of M.P.E.P. § 806.05(f) (citation omitted): “A product defined by the process by which it can be made is still a product claim . . . ; defining the product in terms of a process by which it is made is nothing more than a permissible technique that applicant may use to define the invention.”

Even disregarding M.P.E.P. § 806.05(f), it would still be the case that amended Claim 62 necessarily falls into Group I, the same group as original Claim 62. Claim 62 as originally written was a product-by-process claim, and defined a herbicide-resistant rice plant by its method of production. See limitation (b) of original Claim 62. The December 11, 2002 restriction requirement identified original Claim 62 as being part of Group I for restriction purposes. Regardless of how one views a product-by-process claim, it is clear that Claim 62 as amended falls into the same group for restriction purposes as Claim 62 as originally filed. The Office placed original Claim 62, which was directed to a herbicide-resistant rice plant defined in product-by-process terms, into Group I. It logically follows that amended Claim 62, which is still directed to a herbicide-resistant rice plant, a plant that is still defined in product-by-process terms, necessarily falls into the same Group I.

Dependent product Claims 64, 66, and 68 likewise fall into the same Group as independent Claim 62.

It is respectfully submitted that the December 22, 2004 Communication should be withdrawn, and that at least Claims 62, 64, 66, and 68 should be examined on the merits as corresponding to elected Group I.

Preliminary Note

On April 7, 2004 an Office Action was mailed. On June 3, 2004 an essentially identical Office Action was mailed, without explanation. The June 3, 2004 Office Action is interpreted by Applicant as effectively withdrawing the April 7, 2004 Office Action.

The fee that was due for an extension of time for the October 4, 2004 Amendment was discussed in that paper (pages 1-2).

For the reasons given above, it is respectfully submitted that the previous, October 4, 2004 Amendment was fully consistent with Applicant's earlier election of Group I; and that the Office should therefore withdraw the December 22, 2004 communication. However, should the Office determine that an extension of time is necessary for Applicant to reply to the December 22, 2004 communication, then the Office is respectfully requested to treat the present paper as a petition for any necessary extension of time, and to charge any fees that may be due to the undersigned's deposit account, as provided in the general Deposit Account Authorization that was filed with the application on August 22, 2001.

Preliminary Comments; and a Request to the Examiner

There are two independent Claims: Claim 62, and Claim 71.

Claim 62 has been amended to refer to a herbicide-resistant rice plant produced by a breeding process as specified, employing the plant with ATCC accession number PTA-904.

Claim 71 has been amended to define a rice breeding process employing the plant with ATCC accession number PTA-904.

All Claims other than Claim 62 are identical to the Claims as presented in the October 4, 2004 amendment.

Applicant's intent in presenting these amendments is not to surrender the canceled subject matter. To the contrary, it is Applicant's present intention to pursue the canceled subject matter in one or more continuation applications. Rather, the intention is to accelerate the prosecution of this application, to try to